



EXPEDITED PROCEDURE – EXAMINING GROUP 3625

10/027,420

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant: | Todd A. Schwartz et al. | Examiner: | Rob Rhode |
| Serial No.: | 10/027,420 | Group Art Unit: | 3625 |
| Filed: | December 20, 2001 | Docket No.: | 884.619US1 |
| Title: | PRICING OPTIONS FOR DIGITAL CONTENT PRODUCTS (As Amended) | | |
| Customer Number: | 21186 | | |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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In response to the Final Office Action mailed February 27, 2006, the Applicant requests review of the final rejection in the above-identified Application. No amendments are submitted with this request, which is being filed with a Notice of Appeal for the reasons stated below.

It is respectfully noted that claims 6-7 and 12-24 have been withdrawn from consideration, and not canceled. Thus, with no claims amended, no claims canceled, and no claims added, claims 1-24 are now pending in this Application.

§102 Rejection of the Claims

Claims 1-5 and 7-11 were rejected under 35 USC § 102(e) as being anticipated by Cansler (U.S. 6,725,257 B1; hereinafter “Cansler”). The Applicant does not admit that Cansler is prior art and reserves the right to swear behind this reference at a later date. In addition, because the Applicant asserts that the Office has not shown that Cansler discloses the identical invention as claimed, the Applicant traverses this rejection of the claims.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485

(Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

In the Office Action, it is asserted that Cansler “teaches a digital content pricing system, comprising ... a memory ... including a plurality of digital content items ...”. A careful reading of Cansler reveals that this assertion is incorrect – Cansler teaches an apparatus that permits a user to describe and price a physical item, one that can’t be stored in a memory.

More specifically, the assertion that Cansler “teaches a digital content pricing system” is incorrect because Cansler is directed to describing and pricing a vehicle configuration. *See* Cansler, Col. 3, lines 41-44. A vehicle or “products other than vehicles” that are to be purchased “from a dealer, vehicle broker, or manufacturer” (see Cansler, Col. 4, lines 27-29) are not the same as the claimed digital content items.

The assertion that Cansler “teaches a memory ... including a plurality of digital content items” is incorrect for similar reasons. Cansler’s memory does not include “a plurality of digital content items,” which comprise the products themselves, as claimed by the Applicant. Instead, Cansler merely describes using a database 46 having *information about the products*. *See* Cansler, FIG. 2.

While the Office maintains that “digital content” has been given very little patentable weight, this is not the same as no patentable weight. The Applicant respectfully notes that the term “digital content” is not used only in the preamble of the claim, but also in the claim body. It is not a phrase that merely indicates an intended use, as alleged by the Office, but rather comprises an object that can be stored in a memory, perhaps along with pricing meta-data, and delivered to a purchaser over a network. This type of operation is not possible using the teachings of Cansler. Thus, while the Office asserts that digital content “and associated linked data is considered to be non-functional descriptive material, which does not patentably distinguish the applicant’s invention from Cansler”, this assertion fails to account for the difference between digital content and physical objects that can’t be stored in a memory.

The claims during examination should be interpreted as broadly as their terms reasonably allow. However, that interpretation must be tempered by the context in which the terms are

used. The *Hyatt* court stated that “during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D (BNA) 1664, 1667 (Fed. Cir. 2000) (emphasis added) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”; citing *In re Graves*, 69 F.3d 1147, 1152, 36 U.S.P.Q.2D (BNA) 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 U.S.P.Q. (BNA) 1, 5 (Fed. Cir. 1985) (en banc)).

The interpretation of “digital content” proffered by the Office is neither reasonable, nor consistent with the specification. It is not reasonable because one of skill in the art would understand that digital content comprises something that can itself be stored in a memory, manipulated and altered while stored therein, and subsequently delivered to a purchaser. One of skill in the art would therefore not understand a vehicle to constitute “digital content.”

The interpretation by the Office is also inconsistent with the specification in the Application, which states that digital content includes “on-line novels, software program packages, compact disks, electronic music albums, electronic magazines, movie packages (e.g., similar to or identical to the program content stored on a digital video disk), electronic news services, and similar items” that can be delivered directly to the purchaser over a network. Application, pg. 3, lines 22-25.

Since Cansler does not teach the identical invention claimed, independent claims 1 and 8 (as well as all claims depending from them) are in condition for allowance. Reconsideration and withdrawal of the rejection of claims 1-5 and 8-11 under § 102 as a result of this Pre-Appeal Brief Request for Review is respectfully requested.

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CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney, Mark Muller at (210) 308-5677, or the Applicant's below-named representative to facilitate the prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27 day of April 2006.

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Signature